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22852	7590	08/08/2006	EXAMINER	
FINNEGAN, HENDERSON, FARABOW, GARRETT & DUNNER LLP 901 NEW YORK AVENUE, NW WASHINGTON, DC 20001-4413			GOTTSCALK, MARTIN A	
			ART UNIT	PAPER NUMBER
			3626	

DATE MAILED: 08/08/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/619,748

Applicant(s)

MAU, ANDREAS

Examiner

Martin A. Gottschalk

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 15 May 2006.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 31-58 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 31-58 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Continued Examination Under 37 CFR 1.114

1. A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114.

Applicant's submission filed on 04/20/2006 has been entered.

Notice to Applicant

2. Claims 31-58 are new and have been examined. Claims 1-30 are cancelled.

Claim Rejections - 35 USC § 103

3. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

4. The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

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1. Determining the scope and contents of the prior art.
 2. Ascertaining the differences between the prior art and the claims at issue.
 3. Resolving the level of ordinary skill in the pertinent art.
 4. Considering objective evidence present in the application indicating obviousness or nonobviousness.
5. Claims 31, 32, 39, and 42 are rejected under 35 U.S.C. 103(a) as being unpatentable over the E-Benefits Inc. website (hereinafter E-Benefits) in view of Moderegger (US PG Pub# 2002/0049642).

A. As per claim 31, E-Benefits discloses a computer-implemented method for providing a distributed service marketplace (E-Benefits: pg 3, item 1, reads on "QuoteWizard will instantly search hundreds of...plans..."), the method comprising:

receiving, from a user, requirements for services (E-Benefits: pg 3, item 1. The Examiner considers "Using search criteria that you provide..." to mean the user (employer) requirements (criteria), in order to be used, would have had to have been received from the employer);

electronically preparing a search message including the requirements for services (E-Benefits: pg 3, item 1. The Examiner considers "Using search criteria that you provide..." to indicate preparation of an electronic search message which provides the requirements);

transmitting the search message to one or more service providers (E-Benefits: pg 3, item 1. The Examiner considers E-Benefits to be a form of service provider. The Examiner further considers the employer's provision of "search criteria" to be a form of transmitting a search message to a benefit provider.);

automatically receiving bids from the one or more service providers that satisfy the requirements for services (E-Benefits: pg 3, items 1 and 2. The Examiner considers an employer selecting from "available employee benefits options" to be a form of receiving bids from service providers. Furthermore, since the transmission and receipt of the bids are done by computer, the step is considered to be automatically);

sorting the received bids based on criteria selected by the user (E-Benefits: pg 3, item 2, reads on "comparing prices and benefits");

E-Benefits fails to explicitly disclose the remaining features of claim 1, however, these features are well known in the art as evidenced by the teachings of Moderegger who discloses

automatically selecting a best bid from the received bids based on the sorting (Moderegger: [0018]);

automatically transmitting a contract document to the service provider associated with the best bid (Moderegger: [0056]);

and

automatically receiving the contract document from the service provider associated with the best bid, wherein the contract document includes a status of at least one of

accepted (Moderegger: [0036]; [0057], reads on “awarding of a contract” and “contract has been awarded”),

rejected,

and

amended.

It would have been obvious at the time of the invention to one of ordinary skill in the art to combine the teachings of Moderegger and E-Benefits with the motivation of providing both a competitive bid based on price, as well as providing historical performance data for a particular bidder to allow bidder

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performance to be considered as part of bid selection (Moderegger: [0019]-[0020]).

B. As per claim 32, E-Benefits fails to disclose the features of the claim, however, these features are well known in the art as evidenced by the teachings of Moderegger who teaches the method of claim 31, wherein

if the received contract document includes the status of accepted,

then the contract document further includes an electronic signature of the service provider associated with the best bid (Moderegger: [0041]; [0056]).

C. As per claim 39, E-Benefits discloses a method wherein the benefits comprise at least one of health care benefits, life insurance benefits, savings plans, stock option plans, pension plans, 401K plans, credit plans, flexible spending accounts, and claims processing for flexible spending accounts (E-Benefits: pg. 2, "QuoteWizard" section.).

D. As per claim 42, E-Benefits fails to explicitly disclose the features of the claim, however these features are well known in the art as evidenced by the teachings of Moderegger who discloses the method of claim 31, wherein the search message comprises

networking requirements including at least one of

memory specifications,

operating system specifications,

and

type of task to be executed (Moderegger: [0032], reads on

“document and information exchange” and “databases...where bid-
and performance-related information is respectively retained.”).

6. Claim 33 is rejected under 35 U.S.C. 103(a) as being unpatentable over E-Benefits in view of Moderegger as applied to claim 31 above, and further in view of Proudler (US Pat# 2002/0023212, hereinafter Proudler).

A. As per claim 33, E-Benefits and Moderegger fail to teach the features of this claim, however, these features are well known in the art as evidenced by the teachings of Proudler who teaches the method of claim 31, wherein

if the received contract document includes the status of rejected (Proudler: [0077]),

then automatically selecting a next best bid from the received bids based on the sorting and repeating the automatically transmitting and automatically receiving the contract document steps with the next best bid. (The Examiner considers that just as duplicating of parts is considered obvious, so is duplication of a step obvious when the duplication fails to produce a new or unexpected result as in the present case. Thus given a list of bids and a process leading to the rejection of the first bid on the list, it would be obvious and expected to move onto the next bid and repeat the step until a bid is accepted. In re Harza, 274 F. 2d 669, 124 USPQ 378 (CCPA 1960).

7. Claims 34-36 are rejected under 35 U.S.C. 103(a) as being unpatentable over E-Benefits in view of Moderegger as applied to claim 31 above, and further in view of MacSweeney (MacSweeney, Gregory. "Billing System Drives Cross-Sell Efforts." Insurance & Technology, June 2003; Vol. 28, Issue 6, pg. 23; hereinafter MacSweeney).

A. As per claims 34, 35, and 36 E-Benefits and Moderegger fail to disclose a method, further comprising:

receiving, from the employer, electronic payment for the benefits (claims 34 and 36);

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receiving requests for payment for the benefits from the selected benefits provider (claim 35);

and

transmitting electronic payment for the benefits to the selected benefits provider (claim 36).

However, these features are well known in the art as evidenced by MacSweeney.

MacSweeney discloses a benefits provider who receives electronic payment (MacSweeney: col 2, 2nd paragraph, reads on "accepts electronic payments"; col. 3, 2nd paragraph, note "EFT") for benefits from an employer (MacSweeney: col. 3, 2nd paragraph. Note "customers" making the payments are "benefit administrators", which is read on by employer.) The Examiner notes that the way EFT works is for the customer (in this case a benefits administrator) to transmit funds electronically to a vendor (in this case, a benefits provider) who is set up to receive electronic payments.

MacSweeney also discloses an electronic billing system (MacSweeney: col. 2, 2nd paragraph, in particular "...a Web-based solution...that could provide

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customers with the ability to edit bills electronically..."). The Examiner considers Web-based bills to be a form of a customer (benefits administrators/employers) receiving requests for payment from a benefit provider.

It would have been obvious to one of ordinary skill in the art at the time of the invention to combine the disclosures of MacSweeney with the method of E-Benefits in order to grow revenue (MacSweeney: col. 3, last paragraph).

8. Claims 37 and 38 are rejected under #5 U.S.C. 103(a) as being unpatentable over E-Benefits in view of Moderegger and MacSweeney as applied to claim 36 above, and further in view of Singerman (Singerman, Fredric S. "The Impact of the Electronic Signatures Act on Plan Administration." Journal of Pension Benefits: Issues in Administration, Autumn 2000, Vol. 8, Issue 1, pp. 3-8; hereinafter Singerman).

A. As per claim 37, the collective teachings of E-Benefits, Moderegger, and MacSweeney fail to disclose receiving a carrier receipt from the selected benefits provider.

However, this feature is well known in the art as evidenced by Singerman (Singerman: pg. 6, from beginning of the section titled "DOL Authority" through the first bulleted point of the section.). Singerman discloses a method for plan administrators to comply with regulatory guidance concerning notification of plan

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participants by “using return-receipt electronic mail...to confirm receipt of transmitted information.”

It would have been obvious to one of ordinary skill in the art at the time of the invention to combine the teachings of Singerman regarding return-receipt email with the collective teachings of E-Benefits and MacSweeney in order to increase efficiency by electronically providing plan participants information required by law or regulation (Singerman: pg. 6, section titled “DOL Authority”, first paragraph).

B. As per claim 38, the collective teachings of E-Benefits, Moderegger, and MacSweeney fail to disclose transmitting a carrier receipt to the employer.

However, this feature is well known in the art as evidenced by Singerman (Singerman: pg. 6, from beginning of the section titled “DOL Authority” through the first bulleted point of the section.). Singerman discloses a method for plan administrators to comply with regulatory guidance concerning notification of plan participants by “using return-receipt electronic mail...to confirm receipt of transmitted information.”

The motivation for combining the teachings of Singerman with the collective teachings of E-Benefits and MacSweeney is as given above in the rejection of claim 37 and is incorporated herein.

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9. Claim 40 and 41 are rejected under 35 U.S.C. 103(a) as being unpatentable over E-Benefits in view of Moderegger as applied to claim 31 above, and further in view of Thompson et al (PG Pub No. 2003/0229522); hereinafter Thompson.

A. As per claims 40 and 41, E-Benefits and Moderegger fail to explicitly disclose a method comprising:

receiving, from the employer, a request to change (or stop) benefits for the employee;

and

transmitting, to the selected benefits provider, the request to change (or stop) benefits.

However, these features are well known in the art as evidenced by Thompson.

Thompson teaches an electronic system for benefits management (Thompson: Abstract and Fig. 1) where an employer can transmit a request to change (or stop) employee benefits which is received by a benefits provider

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(Thompson: [0206]; Fig. 2A, items 296, 300, and 302; note that request to change (or stop) employee benefits reads on "amendment request".) The Examiner considers change (or stop) requests to be specific examples of amendment requests.

It would have been obvious to one of ordinary skill in the art at the time of the invention to combine the method of E-Benefits with the teachings of Thompson to eliminate formerly paper-driven processes, thus improving productivity, reducing administrative expense, and improving data accuracy by removing human error (Thompson: [0012]).

10. Claim 43 is rejected under 35 U.S.C. 103(a) as being unpatentable over E-Benefits in view of Moderegger as applied to claim 31 above, and further in view of Tomsen (Tomsen, Mai-lan; Killer Content: Strategies for Web Content and E-Commerce; Addison Wesley Longman, Inc. Reading, Massachusetts; April, 2000; pgs 13; 129-133; and 177-180.; hereinafter Tomsen).

A. As per claim 43, E-Benefits suggests the method of claim 31, further comprising

providing a reimbursement to each of the service providers that provided the bids (E-Benefits: pg 3, item 3. The Examiner considers the step of

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“QuickEnroll” to include a payment from a purchaser to the selected benefit provider.).

E-Benefits in view of Moderegger fail to explicitly show this feature.

However, this feature is well known in the art as evidenced by the teachings of Tomsen.

Tomsen discloses the implementation of an “affiliate program” where a first web site publisher pays a second for driving customer or user traffic to the first web site. Typically the payment is a percentage of a sale made by the first web site to a user who arrives at the first web site via a link provided on the second website (Tomsen: pg 13, first paragraph and boxed information at bottom of page). Some programs are not based on a transaction, but are used simply to drive up site traffic and increase brand recognition. So for instance, following the teachings of Tomsen, E-Benefits could place a banner on other benefits providers web sites and pay the providers for every user who links to the E-Benefits site from another benefits providers sites (Tomsen: pg 129, section labeled “Set Up Smart Affiliate Relationships”, first paragraph).

It would have been obvious to one of ordinary skill in the art at the time of the invention to combine the teachings of Tomsen with the method of E-Benefits, with the motivation being to widen the breadth of the E-Benefits net user base

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(Tomsen: pg 129, section labeled "Set Up Smart Affiliate Relationships", first paragraph).

11. Claims 44-58 are rejected for substantially the same reasons as provided above for claims 31-43.

Response to Arguments

12. Applicant's arguments with respect to claims 31-58 presented on pages 11-12 of the response filed 04/20/2006 have been considered but are moot in view of the new ground(s) of rejection.

Conclusion

13. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. The cited but not applied prior art discloses systems and methods to manage employee benefits, on-line evaluation and negotiation of contracts, and provision of contracts, including digital signatures.

14. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Martin A. Gottschalk whose telephone number is (571) 272-7030. The examiner can normally be reached on Mon - Thurs 8:30 -6 and alternate Fri 8:30 - 5.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Joseph Thomas can be reached on (571) 272-6776. The


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fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.



MG
07/20/2006



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